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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,006

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Hsi-Kang Tsao

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04/29/2009

RABIN & Berdo, PC  
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EXAMINER

NGUYEN, KHAI N

ART UNIT

PAPER NUMBER

2614

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/797,006	<b>Applicant(s)</b> TSAO, HSI-KANG	
	<b>Examiner</b> KHAI N. NGUYEN	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 1/27/2009 has been entered. Claims **8** and 9 have been amended. No Claims have been cancelled. No claims have been added. Claims 1-45 are still pending in this application, with claims 1, **8**, 17, 24, 31, 38, and 45 being independent.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because figures 2, 4a & 4b fail to show any details in the form of labels or recognizable shapes as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. See MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawings sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

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made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25-30 are rejected under 35 U.S.C. § 112, second paragraph as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claim 24 is drawn toward "A storage medium for storing a computer program - - -", but its dependent claims 25-30 recite "The method as claimed - - -", and appear to be applied for a method claim. Therefore, it cannot be concluded with a complete assurance that claims 25-30 are the method or the manufacturing/article/product claims. Appropriate correction is required.

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5. Claims 31-37 are rejected under 35 U.S.C. § 112, second paragraph as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 is drawn toward “A computer system - - -”, and then recites “- - -, the method comprising the steps of: - - -”, in addition, the dependent claims 32-37 recite “The method as claimed - - -”, and appear to be applied for a method claim (i.e., comprises the steps: - - -). Therefore, it cannot be concluded with a complete assurance that claims 24-30 are the method or the apparatus/system claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-45 appear to directed to a method, a system, manufacturing (a storage medium for storing a computer program), however according to the specification the invention is disclosed as “methods and apparatus of the invention may also be embodied in the form of program code - - -” (See the instant specification page 18, lines 15-17, and lines 23-25).

Therefore, these claims are interpreted as software claims which are non-statutory. Software, or logic, or any type of “functional descriptive material”, is not statutory when claimed as descriptive material, per se. See MPEP 2106 Patent Subject

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Matter Eligibility, MPEP 2106.01 Computer-Related Nonstatutory Subject Matter, and pages 50-57 of “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”.

8. Claims 24-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 24-30 appear to directed to a manufacturing article/product (a storage medium for storing a computer program), however according to the specification the storage medium is disclosed as “- - - some transmission medium, such as electrical wiring, through fiber optics, - - -” which can be interpreted as a “modulated carrier signal transmitted over a medium”, and medium such as “electrical, optical” (See the instant specification page 18, lines 23-27). Signals, magnetic field, and carrier signal did not fall within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter).

Therefore, the claimed invention can be interpreted as carrier signal, signals, or electric/magnetic fields which are not statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

9. Claims 1-6, 10-11, 13-14, 16-22, 26-29, 32-36, 39-40, and 43-44 are rejected under 35 U.S.C. 103(a) being anticipated by Prindle (US 2003/0232648 A1) in view of “A Primer on the H.323 Series Standard hereinafter “Primer””.

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Prindle discloses a system that provides a real-time video conferencing system using a video game console and a network connection (par. 21, lines 2-3). The video game console is connected to other game clients that support the H.323 standard: a console or personal computer on a peer-to-peer (P2P) network (par. 174, lines 1-6). The H.323 standard is an international telecommunication standard that provides a specification for computers on how to provide multimedia communications over networks that do not provide a guaranteed QOS (Quality of Service) (par. 16, lines 1-6).

Regarding claim 1, a DVD containing the video conferencing program in a video game format is insert into a game console (par. 126, lines 4-6) and captures the AV data through a microphone and camera connected to the game console (fig. 3; 38, 37, 43) over a P2P network (abstract). The system uses H.323 standard to supplying real-time audio and video data over a network. The relevant components of this standard are audio & video (AV) Codec(s) or coder/decoders (par. 17, lines 6-8); framing further comprising logical framing, sequence numbering and error detection; packaging & sending data for file transferring & programming sharing, Real-Time protocol (RTP) & Real-Time Control Protocol (RTCP), using H.245 to connect a console with another and AV streaming (par. 24, lines 6-22). Therefore the system can connect and transfer packets of compressed & encoded AV data to another console for decoding and play back on a TV set (par. 23, lines 10-14). Furthermore, all the game consoles or clients are connected directly to one another and not a game server since the system uses a P2P network (par. 182, lines 1-4). And, the system also discloses synchronizing the

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operation of the system with other computers (par. 36, lines 3-4). After initiating a call, H.255 is able to send and receive different media types simultaneously and each one has their own sequence of numbers that allow the system to receive packets in the proper order so a user can see and hear the information correctly (par. 148, lines 1-9).

Regarding claims 2, 16, 18, 20, 25, 27, 32, 34, and 39, the system discloses that a user can place a call in several ways; typing in a computer address or looking up a stored history list of people who has called before from an Internet Directory (ID) that creates a directory list of users (par. 193, lines 1-16). The information stored in each person's listing is their name, location or IP address and any other important information (par. 201, lines 4-8). Therefore the system allows a user to control a game client to retrieve the Internet address of another game client (second, third, etc.) (par. 120) from a directory and use this information to establish a connection for the purpose of transmitting data.

Regarding claims 3, 10, 19, 26, 33, and 40, the specification disclosed the H.323 standard as an important component to the system. Even though certain features of the standard are missing from the specification, the entire standard is considered to be incorporated by reference. The H.323 contains a bandwidth management protocol that regulates the amount of bandwidth that available to H.323 applications (Primer). Once the available bandwidth is determined the standard selects the proper codec for the connection (Prindle: par. 158, lines 1-3): H.261 transmits video 64 Kbps (Prindle: par.



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164, lines 1-3) and H.263 transmits video at 28.8 Kbps (Prindle: par. 166, lines 1-8) are just two examples of possible Codec(s). Since the standard is built under the philosophy that the quality of the multimedia is not guaranteed (Prindle: par. 16, lines 4-5) the standard is able to adapt the transmission rate (Prindle: par. 36, lines 3-4) based on the limited bandwidth using many different solutions like the different Codec(s) mentioned above or a simple solution like giving the audio data priority over the video packets.

Regarding claims 4-6, 11, 13-14, 21-22, 28-29, 35-36, and 43-44, the system discloses synchronizing the operation of the system with other computers (par. 36, lines 3-4). After initiating a call, H.255 is able to send and receive different media types simultaneously and each one has their own sequence of numbers that allow the system to receive packets in the proper order so a user can see and hear the information correctly (par. 148, lines 1-9).

Regarding claim 17, the same limitations are found in claim 1 therefore this rejection is made under the same reasons. The Examiner would like to further point out that the DVD that contains the video conferencing software (par. 126, lines 4-6) is viewed as an Internet game since the software needs the Internet to perform its functions that are entertaining.

***Claim Rejections - 35 USC § 103***

10. Claims 8-9, 12, 24, 31, 38, 41-42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prindle in view of “A Primer on the H.323 Series Standard”, and in view of IGN Staff (E3 2002: All About Xbox Live hereinafter “All About Xbox Live”).

Regarding claims 8-9, 12, 24, 31, 38, 41-42, and 45, all of the limitations were discussed in the rejection of claim 1 and 15 except for the limitation of the game server executing an Internet game. A limitation that is not discussed by Prindle even though one of the unique features of an XBOX (Prindle: par. 14, line 3) is the XBOX LIVE service. Microsoft tried to distinguish itself from the competition by creating a game network of game servers (Live: par. 11, lines 1-2) that would provide XBOX owners certain unique services: instant messaging (Live: par. 10, lines 1-5), match making (par. 8, lines 1-10), voice communication (Live: par. 7, lines 2-4) and downloadable content (Live: par. 12, line 1). Once a server matches the players, the execution of an Internet game on the LIVE network occurs in each participating console (Live: par: 10, lines 5-6) and a game server (Live: par. 10, lines 3-11). The purpose of the LIVE network is to expand the entertainment and communication experience of a gamer or as the article puts it as Microsoft is trying to create an “online community” (Live: par. 10, line 1) from a player’s “global couch” (Live: par. 8, line 1). One of ordinary skill would view this already established XBOX LIVE (client-server) network as a cost effective solution to the P2P network described by Prindle and would alter the disclosed system to function on the

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XBOX LIVE network to fulfill the entertainment and communication goals of the system described by Prindle.

11. Claims 7, 15, 23, 30, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prindle in view of "A Primer on the H.323 Series Standard", "All About XBOX Live" and Peer Schneider (Mario Artist: Talent Studio (Import)).

Regarding claims 7, 15, 23, 30, and 37, the above description of the invention disclosed by Prindle, the Primer and XBOX LIVE and the limitations they pertain is considered within this art rejection as well. All of the disclosed references remain silent about implementing video data into a gaming environment as texture mapping.

However, "Mario Artist: Talent Studio" discloses capturing a person's face through a camera (Mario: par 3) and maps the image on game character's (Mario: par 1) polygonal head (Mario: par. 3); a technique called texture mapping. This feature provides another level of customization (Mario: par. 4) therefore an ordinary artisan would implement this technology as another level of customization of an XBOX Live account and another in-game feature (LIVE: "How it Will Work", par. 3).

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAI N. NGUYEN whose telephone number is (571)270-3141. The examiner can normally be reached on Monday - Thursday 6:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. N. N./  
Examiner, Art Unit 2614  
04/23/2009

/Ahmad F Matar/  
Supervisory Patent Examiner, Art Unit 2614

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